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10/677,713	10/02/2003	Daniel M. Martelli	1200212R	9171
35227	7590	05/11/2009	EXAMINER	
POLYONE CORPORATION 33587 WALKER ROAD AVON LAKE, OH 44012				CHEVALIER, ALICIA ANN
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/677,713

Filing Date: October 02, 2003

Appellant(s): MARTELLI, DANIEL M.

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John H. Hornickel  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 4, 2009 appealing from the Office action  
mailed June 12, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

## (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

## **(8) Evidence Relied Upon**

5,384,173 AKAO et al. 01-1995

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 102***

1. Claims 1-4, 6, 8-10, 13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Akao et al. (U.S. Patent No. 5,384,173).

Akao discloses a molded thermoplastic container (*title*) comprising an outer surface with an etc pattern, which is deemed to be a matte finish, and a colorant present in the thermoplastic product ranging from about 0.01 to about 15 parts by weight of thermoplastic resin (*col. 12, lines 65-66*). The colorant is deemed to be a frost colorant and light-diffusing particles since it is made from barium sulfate (*col. 12, lines 50-51*). The thermoplastic resin is transparent (*col. 3, line 25*). The particles are present in the thermoplastic product ranging from about 0.2 to about 5 parts by weight of thermoplastic resin and comprises any form of powders, fibers, whiskers, platelets, flakes, aggregated or mixtures of these (*col. 12, lines 50-51*). The etched pattern has depressions ranging from about 0.1 to about 100 microns, more specifically about 0.5 to 10 microns (*col. 2, lines 49-51*). The ratio of depressions to lands in the surface area can range from

about 1 to about 90 percent, more specifically about 50 to about 80 percent (*col.2, lines 47-49*).

The light-diffusing particles are deemed to add diffused translucency and the etched pattern is deemed to add tactile texture to the product.

The limitation “the etched pattern is microreplicated” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

***Claim Rejections - 35 USC § 103***

2. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al. (U.S. Patent No. 5,384,173).

Akao is relied upon as described above.

Akao fails to disclose the average maximum particle size of about 0.1 to about 200 microns.

It is deemed a matter of optimization via routine experimentation of properties to make the particle size from about 0.1 to about 200 microns as recited in Appellant’s claim 15 when making the product. See MPEP 2144.05.

**(10) Response to Argument**

3. Appellant's arguments in Appeal Brief filed, February 4, 2009, regarding the 35 U.S.C. 102(b) rejection over Akao et al. (U.S. Patent No. 5,384,173) of record have been carefully considered but are deemed unpersuasive.

Appellant argues that Akao does not disclose "an outer surface having a matte finish with an etch pattern ..." as required by claim 1. Applicant further points out that the matte finish in Akao is on the "inner peripheral wall" of a container.

The fact that Akao uses the matte finish surface as the inner wall of a container does not diminish the fact the inner wall of the container is still an outer surface. The only requirement of an outer surface is that it is not covered another layer. The container of Akao has two outer most surfaces, one that forms the outer wall and one that forms the inner wall.

4. Appellant's arguments in Appeal Brief filed, February 4, 2009, regarding the 35 U.S.C. 103(a) rejection over Akao et al. (U.S. Patent No. 5,384,173) of record have been carefully considered but are deemed unpersuasive.

Appellant argues that particle size does play a role in the selection of Appellant's frost colorant and that no one in the art would look to Akao to find the right particle sizes.

Applicant has not presents evidence showing criticality in the claimed particle size. Furthermore, attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are

not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Alicia Chevalier/

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/David R. Sample/  
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QAS, TC1700